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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Che-Kuei Mai

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12/23/2008

LIU & LIU

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LOS ANGELES, CA 90071

EXAMINER

NGUYEN, JIMMY H

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/830,206	Applicant(s) MAI, CHE-KUEI	
	Examiner JIMMY H. NGUYEN	Art Unit 2629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,9-13,16-20 and 22-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,9-13,16-20, and 22-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is made in response to applicant's amendment filed on 10/2/2008. Claims 1, 9-13, 16-20, and 22-29 are currently pending in the application. An action follows below:

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 28 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As to claim 28, this claim recites a limitation, "wherein the first and second conductive layers are respectively formed on the first and second substrates at the same time with" in lines 1-3, which was not supported in the application as filed.

The original disclosure, specifically the specification, page 8, lines 1-7, explicitly discloses "[T]he first conductive film 12a (corresponding to the claimed first conductive layer) and the top conductive film 12 can be formed, for example, on the lower surface of the top transparent substrate 10 (corresponding to the claimed first substrate) **at the same time**. The third conductive film 22a (corresponding to the claimed second conductive layer) and the bottom conductive film 22 can be formed on the upper surface of the bottom transparent substrate 20 (corresponding to the claimed second substrate) **at the same time**. Note that the texts in the

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above parenthesis are added to match the claimed elements with the corresponding elements in the specification. The original disclosure does not explicitly disclose the same time in the first sentence of the mentioned disclosure being the same as the same time in the second sentence of the mentioned disclosure. In other words, the mentioned disclosure does not explicitly teach that a formation of the first conductive layer (12a) on the first substrate (10) and a formation of the second conductive layer (22a) on the second substrate (20) are done at the same time.

Accordingly, the original disclosure does not contain such description and details regarding to the above underlined limitation of claim 28, so as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 9, 24-26 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 9, since this claim depends upon the cancelled claim 7, it is considered that the invention of claim 9 is not clearly defined.

As to claims 24, 25, and 29, these claims recite a limitation, “a third conductive layer of a different material” in last line of claims 24-25 and in last two lines of claim 29. Since it is unclear that the above underlined limitation requires a third conductive layer having a material different from a material of the first substrate, the second substrate, the sensing lines, the first conductive surface, the second conductive surface, the first conductive layer, the second

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conductive layer, or other, it is considered that the invention of these claims is not clearly defined.

As to claim 26, since this claim depends upon claim 25, this claim is therefore rejected for the same reason set forth in claim 25 above.

Notice to Applicant

6. Due to the above rejection under 35 USC 112, under 35 U.S.C. 112, second paragraph, to claims 24-26 and 29 and in order to further consider these claims, Examiner considers “a third conductive layer of a **different** material” in last line of claims 24-25 and in last two lines of claim 29 requiring “a third conductive layer having a material different from a material of the claimed first substrate or the claimed second substrate” because the original disclosure, specifically the specification, page 6, lines 3-5, discloses “[T]he top and bottom transparent substrates can be glass or plastic. For example, the top and bottom transparent substrates 10 and 20 can be **polyester plastic, with PET** (polyethylene terephthalate) being a representative example” (note that the top and bottom transparent substrates 10 and 20 respectively correspond to the claimed first and second substrates) and the original disclosure, specifically the specification, page 8, lines 7-9, discloses “[I]n this case, the second conductive film 2a can be a metal film, such as a **silver film**, having a thickness as the thickness of the spacer 50” (note that the second conductive film 2a corresponds to the claimed third conductive layer), i.e., the material of the claimed third conductive layer is different from the material of the claimed first substrate or the claimed second substrate.

Claim Rejections - 35 USC § 102

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7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims **1, 9-13, 16-20, 22-27, and 29** are rejected under 35 U.S.C. 102(b) as being anticipated by Okahashi (US 6,473,074 B1).

As to **claim 1**, Okahashi discloses a touch panel input device (a coordinate input device 10; see Fig. 1A or 2; col. 4, line 48) comprising:

a contact sensitive panel (Figs. 1A, 2) comprising a first substrate (element 22; Fig. 2; col. 4, lines 56-57) and a second substrate (element 16; Fig. 2; col. 4, lines 34-35) insulated from the first substrate (Fig. 2), wherein the first substrate (22) has a first conductive surface (a resistant film 20; Fig. 2; col. 4, line 58) and the second substrate (16) has a second conductive surface (a resistant film 14; Fig. 2; col. 4, line 55) facing the first conductive surface (20) (Fig. 2), and wherein the first conductive surface and the second conductive surface define an active area (Figs. 1A and 2; col. 6, line 66 through col. 7, line 11);

sensing lines (electrodes 28, 34; Fig. 1A) at the periphery of the active area, which facilitates sensing relative changes in electrical properties arising from user contact within the active area (col. 5, lines 16-44); and

a grounding conductor (ground conductor element 38; Fig. 1A; col. 5, line 46) conductively coupled to the contact sensitive panel outside the active area (Figs. 1A and 2), and configured to be conductively insulated from the sensing lines (28, 34) and the first and second

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conductive surfaces (20, 14) and conductively coupled to an external ground (a frame ground) (see col. 6, lines 32-36),

Okahashi further teaches that the grounding conductor (38) comprises a first section (a section of ground conductor element 38 around the resistant film 14; Figs. 1A, 2) attached to the contact sensitive panel (Fig. 1A, 2) and a second section (distal ends 38a; Fig. 1A) extending from the first section to the external ground (Fig. 1A; col. 6, lines 32-36).

Okahashi teaches that the first substrate (22) is exposed to contact by a user (col. 6, line 66 through col. 7, line 11), and wherein the grounding conductor (38) is conductively coupled to the first substrate (22) and the second substrate (16) (Fig. 2).

Okahashi further discloses the grounding conductor (38) comprising a first conductive layer (an upper layer of the ground conducting element 38; Fig. 2) on the first substrate (22) on the same side as the first conductive surface (20), a second conductive layer (a lower layer of the ground conducting element 38) on the second substrate (16) on the same side as the second conductive surface (14), wherein the first and second conductive layers are conductively coupled (Fig. 2). **Note that since claim 1 does not require the first conductive layer being distinct or separate from the second conductive layer, the ground conducting member 38 of Okahashi considerably comprises three integrated layers such as an upper layer corresponding to the claimed first conductive layer, a middle layer, and a lower layer corresponding to the claimed second conductive layer (see Fig. 2).**

Regarding to the claimed limitation, “wherein the first and second conductive layers are respectively formed on the first and second substrate along with the first and second conductive surfaces on the first and second substrates” in last two lines of claim 1, Examiner notes that this

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underlined limitation requires “the first conductive layer is formed on the first substrate along with the first conductive surface on the first substrate” and “the second conductive layer is formed on the second substrate along with the second conductive surface on the second substrate”. As noting in Fig. 2, Okahashi explicitly discloses the first conductive layer (an upper layer of the ground conducting member 38; see the above bold note) formed on the first substrate (22) along with the first conductive surface (20) on the first substrate (22) and the second conductive layer (a lower layer of the ground conducting member 38; see the above bold note) formed on the second substrate (16) along with the second conductive surface (14) on the second substrate (16).

Accordingly, all elements of this claim are read in the Okahashi reference.

As to **claims 9 and 11**, Okahashi discloses the grounding conductor (38) comprising a generally loop shaped structure (Fig. 1A).

As to **claims 10 and 13**, Okahashi discloses the loop extending along the periphery of the contact sensitive panel (Fig. 1A).

As to **claim 12**, Okahashi discloses the generally loop shaped structure being a complete closed loop (Fig. 1A).

As to **claim 16**, Okahashi discloses a display system comprising a touch panel and a display element operatively coupled to the touch panel, wherein locations on an active area of the contact sensitive panel correspond to locations on a display area of the display element (col. 11, lines 28-31). Further, see col. 1, lines 12-23.

As to **claim 17**, Okahashi discloses the display element being a LCD or a CRT (col. 11, lines 28-31).

As to **claims 18 and 19**, Okahashi discloses that a touch sensitive input device can be incorporated in the display such as a LCD or CRT (col. 11, lines 28-31) included in a personal computer, a word processor, or an electronic notebook (i.e., the claimed electronic device) (col. 1, lines 12-23). Further note that a personal computer or notebook computer inherently comprises a device controller coupled to the display system and configured to process data corresponding to an image to be tendered by the display system.

As to **claim 20**, since all limitations of this claim are recited in claim 1, this claim is therefore rejected for the same reason set forth in claim 1 above. See the rejection to claim 1 above.

As to **claims 22 and 23**, Okahashi discloses that the first conductive film (a resistance film 20) defines the first conductive surface (Fig. 2; col. 4, line 58) and a second conductive film (a resistant film 14) defines the second conductive surface (Fig. 2; col. 4, line 55).

As to **claims 24 and 25**, these claims recite limitations, “wherein the first and second conductive layers are conductively coupled by a third conductive layer of a different material”, which require a limitation (i) “the first and second conductive layers are conductively coupled by a third conductive layer” and a limitation (ii) “a third conductive layer having a material different from a material of the claimed first substrate or the claimed second substrate” (see the above Notice to Applicant section). Regarding to the limitation (i), as discussed in the rejection to claim 1 above, the ground conducting member (38) considerably comprises three integrated conductive layers such as an upper conductive layer corresponding to the claimed first conductive layer, a

middle layer corresponding to the claimed third conductive layer, and a lower layer corresponding to the claimed second conductive layer (see Fig. 2). Regarding to the limitation (ii), Okahashi discloses the ground conductor element (38) being made of silver-carbon mixture or aluminum (col. 7, lines 65-67) and the first and second insulating substrates being made of polyethylene terephthalate (col. 7, lines 50-52).

Accordingly, all elements of this claim are read in the Okahashi reference.

As to **claims 26 and 27**, see the rejection to claim 1 above.

As to **claim 29**, since all limitations of this claim are similar to limitations of claim 24 (note that claim 24 includes all limitations of claim 1), this claim is therefore rejected for the same reason set forth in claim 24 above. See the rejection to claims 1 and 24 above.

Response to Arguments

9. Applicant's arguments filed 07/07/2005 have been fully considered but they are not fully persuasive because as follows:

With respect to the rejections under 35 USC 112, first paragraph, to claims 17 and 19 in the Office action dated 07/01/2008, Applicant's argument (see pages 8-9 of the amendment) regarding to the limitations recited in claims 17 and 19 in the previous amendment dated 2/27/2008, have been considered but they are not persuasive. However, because claims 17 and 19 are currently amended to comply with the enablement requirement, the rejection under 35 USC 112, first paragraph, to claims 17 and 19 in the Office action dated 07/01/2008, have been withdrawn. Note that if the Applicant believes that the rejections under 35 USC 112, first paragraph, to claims 17 and 19 in the Office action dated 07/01/2008 are improper, Applicant

should not amend these claims, thereby avoiding confusion that the argument is based on the currently amended claim(s) or the previously rejected claim(s).

With respect to the currently amended claim 1, Applicant's arguments, on page 10, first paragraph, of the amendment filed 10/2/2008,

“As amended, claim 1 requires the first and second conductive layers respectively formed on the first and second substrates along with the first and second conductive surfaces on the first and second substrates. Okahashi does not disclose respectfully **forming the first and second conductive layers along with (i.e., at the same time with) the first and second conductive surfaces.** Okahashi discloses a single structure for its ground conductor element made of a single piece of material. As such, it can at most be formed either on the first detecting member 16 or the second detecting member 22, but not respectively formed on the first detecting member 16 and the second detecting member 22.”,

have been fully considered but they are not fully persuasive because as follows:

(i) “forming the first and second conductive layers **along with** the first and second conductive surfaces” is not the same or does not require “forming the first and second conductive layers **at the same time with** the first and second conductive surfaces”

(ii) as discussed in the above detailed rejection, the claimed limitation, “wherein the first and second conductive layers are respectively formed on the first and second substrate along with the first and second conductive surfaces on the first and second substrates” requires “the first conductive layer is formed on the first substrate along with the first conductive surface on the first substrate” and “the second conductive layer is formed on the second substrate along with the second conductive surface on the second substrate”. As noting in Fig. 2, Okahashi explicitly discloses the first conductive layer (an upper layer of the ground conducting member 38; see the above bold note) formed on the first substrate (22) along with the first conductive surface (20) on the first substrate (22) and the second conductive layer (a lower layer of the ground conducting member 38; see the above bold note) formed on the second substrate (16) along with the second conductive surface (14) on the second substrate (16); and

(iii) Applicant further argues that the ground conductor element can at most be formed either on the first detecting member 16 **or** the second detecting member 22, but not respectfully formed on the first detecting member 16 **and** the second detecting member 22. Examiner disagrees because Fig. 2 of the Okahashi reference explicitly shows the ground conductor element (38) respectfully formed on (the top of) the first detecting member 16 **and** (the bottom of) the second detecting member 22.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy H. Nguyen whose telephone number is 571-272-7675. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached at 571-272-7681. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jimmy H Nguyen/

Primary Examiner, Art Unit 2629